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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,428	03/31/2004	Paul Buchheit	060963-5007US	8809
24341 7590 02/20/2009 MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306				
EXAMINER NGUYEN, DUSTIN				
ART UNIT		PAPER NUMBER		
2454				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/816,428

**Applicant(s)**

BUCHHEIT ET AL.

**Examiner**

DUSTIN NGUYEN

**Art Unit**

2454

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 82-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 82-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 02/02/2009.

**DETAILED ACTION**

1. Claims 82-111 are presented for examination.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/10/2008 has been entered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 82-89, 91, 92-96, 98, 99-105, and 107-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Rohall et al. [ US Patent Application No 2003/0163537 ].

5. As per claim 82, Moody discloses the invention as claimed including a method for searching messages in a conversation-based message system [ i.e. system and method for searching and retrieving related messages ] [ Figure 5; and Abstract ], comprising:

at a client, responding to receipt of a query from a requestor, the query having one or more query terms [ i.e. search module provides the user with a query box in which the user may enter one or more search terms ] [ Figure 5; and paragraphs 0009-0012, 0053 and 0054 ], including:

transmitting the query over a network to a conversation management system [ i.e. search module accesses threading service 110 ] [ 108, 100, Figure 1; and paragraphs 0024, 0026, 0053 and 0057 ];

receiving from the conversation management system a list of conversations that match the one or more query terms [ i.e. a list of messages related to the particular message from threading service 110 ] [ paragraphs 0057 and 0064 ], and wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria [ i.e. match user query as well as a set of messages related thereto ] [ paragraphs 0006 and 0057 ] and at least one conversation in the list of conversations comprises a plurality of messages [ i.e. list of related messages may include the matching message and all message in the same thread ] [ paragraph 0057 ]; and

presenting at least a portion of the list of conversations to the requestor [ i.e. display the search results in various ways ] [ paragraphs 0012, 0058-0060 ], each conversation in presented portion of the list being represented as a single item [ paragraphs 0014, 0015, 0059 and 0060 ].

Moody does not specifically disclose each of the conversations in the list having a respective conversation identifier.

Rohall discloses

each of the conversations in the list having a respective conversation identifier [ i.e. data identifying a root document of the conversation thread ] [ Figure 4; and paragraphs 0017 and 0057-0059 ].

It would have been obvious to a person skill in the art at the time the invention was made to incorporate the teaching of Rohall to the system of Moody since it would enable to generate electronic mail conversation threads to be stored in memory and manipulated with conventional operations [ Moody, paragraphs 0005, 0009-0011 ].

6. As per claim 83, Moody discloses wherein the conversations are presented to the requestor in an order determined in accordance with second predefined criteria [ i.e. display the search results in various ways ] [ paragraphs 0013, 0058-0060 ].

7. As per claim 84, Moody discloses wherein the second predefined criteria includes a date/time value of a most recently received message of a respective conversation [ i.e. display the search results in the order of date ] [ paragraphs 0013, 0058-0060 ].

8. As per claim 85, Moody discloses wherein the second predefined criteria includes a

date/time value of a most recently received message of a respective conversation relevant to the search query [ i.e. display the search results in the order of relevance ] [ paragraphs 0013, 0058-0060 ].

9. As per claim 86, it is rejected for similar reasons as stated above in claims 82 and 83. Furthermore, Rohall discloses at a server: receiving a plurality of messages directed to a user [ i.e. sending and receiving electronic messages ] [ paragraphs 0050 and 0064 ], each message having a unique message identifier; generating a plurality of conversations [ Figure 4; and paragraphs 0017 and 0057-0059 ], generating a plurality of conversations, each conversation including a respective conversation identifier and unique subset of the plurality of messages [ i.e. generates conversation threads ] [ paragraphs 0010, 0011 and 0013 ].

10. As per claim 87, Rohall discloses wherein the respective conversation identifier is distinct from a subject reference of the message [ Figure 4; and paragraphs 0057-0060 ].

11. As per claim 88, Rohall discloses wherein the respective conversation identifier is based in part on information not including a subject reference of the message [ Figure 4; and paragraphs 0057-0060 ].

12. As per claim 89, Moody discloses wherein each conversation comprises messages sharing a common set of characteristics that meet second predefined criteria [ paragraphs 0013, and 0058-0060 ].

13. As per claim 91, Moody discloses wherein the common set of characteristics include the subject reference of the messages and at least one characteristic of the messages other than the subject reference [ i.e. construct item of dynamic interest profile ] [ Figure 6; Abstract; and paragraphs 0061-0065 ].

14. As per claim 92, it is rejected for similar reasons as stated above in claim 85.

15. As per claims 93-96 and 99, they are rejected for similar reasons as stated above in claims 86-89 and 92.

16. As per claim 98, it is rejected for similar reasons as stated above in claim 91.

17. As per claims 100 and 101, they are rejected for similar reasons as stated above in claims 82 and 83.

18. As per claims 102-105 and 108, they are rejected for similar reasons as stated above in claims 86-89 and 92.

19. As per claim 107, it is rejected for similar reasons as stated above in claim 91.

20. As per claims 109 and 110, they are rejected for similar reasons as stated above in claims 82 and 83.

21. As per claim 111, it is rejected for similar reasons as stated above in claim 82.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 90, 97, 106 rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Rohall et al. [ US Patent Application No 2003/0163537 ], and further in view of Douglas E. Comer and Larry L. Peterson, "Conversation-Based Mail" [ hereinafter as Comer ].

24. As per claim 90, Moody and Rohall do not specifically disclose wherein the second predefined criteria include having a close temporal relationship among the unique subset. Comer discloses wherein the second predefined criteria include having a close temporal relationship among the unique subset [ page 8, lines 19-35 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Moody, Rohall and Comer because the teaching of Comer would enable to provide tools to organizing



the message presented to the user, archiving message for future reference, and reducing the volume of messages [ Comer, page 301, paragraphs 4-7 ].

25. As per claim 97, it is rejected for similar reasons as stated above in claim 90.

26. As per claim 106, it is rejected for similar reasons as stated above in claim 90.

27. Applicant's arguments with respect to claims 82-111 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/  
Primary Examiner, Art Unit 2454